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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,563	05/10/2001	Hirokazu Uchio	B422-150	6252

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/852,563	Applicant(s) UCHIO ET AL.	
	Examiner Neveen Abel-Jalil	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/22/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. The Amendment filed on 5/22/2006 has been received and entered. Claims 33-35 are newly added. Therefore, claims 1-24, and 27-35 are pending, of which claims 1-24 are withdrawn.

Election/Restrictions

2. This application contains claims 1-24 drawn to an invention nonelected without traverse on 5/9/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

3. Claims 32-35 are objected to because of the following informalities:

Independent claim 27 is directed to "An information processing apparatus" in the preamble, later on, dependent claims 33-35, introduce the statement of "An information processing apparatus according to claim 27" making it vague and unclear to the Examiner if a new method separate from the proceeding one, takes place, after the initial process or if the claims are meant to be independent claims and therefore should be written as such. Claims 33-35 lack sufficient antecedent basis.

Dependent claims should be constructed to be preformed the same method introduced in the Independent claim of which they dependent. Correction is required.

Claim 32, recite “code *for*”, in various lines, which constitute intended use and does not carry patentable weight since it never has to occur. Claim should be amended to recite more firm and positive language (i.e. “to” or “that”).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 32 is not statutory because it is merely reciting a number of computing steps without producing any tangible result and/or being limited to a practical application. The use of a computer has not been indicated. The claim does not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim.

In claim 32, “a program” is software per se which needs to be stored and executed on a computer in order to realize its functionality. “Program for realizing an information processing method” is only code that never actually gets executed on a computer or processor. The claim should be amended to recite “program executed on a computer to perform an information processing method...”.

Furthermore, claim 32’s preamble recite “program *for*” the limitations following the phrase “*for*” describes only intended use but not necessarily required functionality of the claim.

Limitations following the phrase “*for*” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28, line 3, recite the vague and indefinite “prior art disclosure procedure” without any prior reference or further indication of what constitute that procedure and what its relationship to the remaining claims. Clarification is required.

Claim 34 recites the limitation "the obtain" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 35 recites the limitation "the abstract" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 34, and 35, both recite the limitation "the first and second prior arts" in the last sentence. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 27-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindh (U.S. Pub. No. 2002/0022974 A1).

As to claims 27, 31, and 32, Lindh discloses an information processing method, apparatus, and program storage medium storing a program for realizing an information processing method, comprising the steps of:

accumulation means for accumulating information about a related prior art document which is cited in a prosecution of a patent application in a first country and a related prior art document cited in another prosecution of a counterpart patent application in a second country different from the first country (See page 4, paragraphs 0039-0040, wherein all citation information is stored in the database is taught); and

display control means for displaying a list of the related prior art documents cited in each of the prosecutions of the patent application in the first country and the counterpart patent

Art Unit: 2165

application in the second country (See Figure 7, shows display of list of countries including designated, also see page 3, paragraph 0037, and page 5, paragraph 0049) .

As to claim 28, Lindh discloses wherein said display control means displays a flag indicating whether or not a prior art disclosure procedure has been performed on the prior art document (See page 3, paragraph 0032).

As to claim 29, Lindh discloses wherein said display control means displays descriptions indicating correspondence between the prior art document and a rejection reason (See page 2, paragraph 0026, also page 3, paragraph 0036).

As to claim 30, Lindh discloses wherein said display control means displays a list of applications by which the prior art document has been cited relating to the prior art document (See page 2, paragraph 0018, column 1, teaches variety of display choices including related patents, prior art, country, etc.).

As to claim 33, Lindh discloses wherein said display means displays country information corresponding to the first and second countries (See page 4, paragraph 0045, wherein “country information corresponding to the first and second countries” reads on “list of countries that patents are designed for or filed”).

As to claim 34, Lindh discloses wherein said display means displays date information which relate to the obtain date of the first and second prior arts (See page 4, paragraph 0040, also see Figure 6, 610, shows dates)

As to claims 35, Lindh discloses wherein said display means displays the abstract of the first and second prior arts (See page 4, paragraph 0043, column 2, wherein comments about abstract is taught).

Response to Arguments

10. Applicant's arguments with respect to claims 27-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2165

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
July 14, 2006


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SUPERVISORY PATENT EXAMINER
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